UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,073	10/31/2001	Raj Jhanwar	MS#164036.1 (4933)	6724

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EXAMINER
FOWLKES, ANDRE R

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/004,073	JHANWAR ET AL.
	Examiner	Art Unit
	Andre R. Fowlkes	2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date *10/31/01*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-35 are pending.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-4, 8-10, 12-23, 25-28 and 30-35 are rejected under 35

U.S.C. 102(e) as being anticipated by Bowler, U.S. Patent Application No.

2002/0174329.

As per claim 1, Bowler discloses **a method for dynamically updating

software stored on one or more installation media for installation on at

least one destination machine** (p. 2 col. L:8-10, "a method for automatically

transitioning files (i.e. installing software) from a source computing system to a

target computing system", and p. 9 col. R:18-21, "(The process may dynamically

update software stored on an installation media, in such a way that the

destination machine receives) new settings (i.e. software) 'calculated' from the

old settings on a (installation media)"), **said method comprising:**

    - obtaining update content from one or more update media remote

from the destination machine (p. 9 col. R:20-24, "(The) process may also be

used for extracting configuration settings (i.e. obtaining update content) from

multiple ... computing systems (i.e. update media) that are local or remote, and

conglomerating them"),

    - merging the update content at the destination machine with the

software on the installation media prior to installing the software on the

destination machine (p. 9 col. R:20-24, "(The) process may also be used for

extracting configuration settings (i.e. update content and software) from multiple

... computing systems that are local or remote, and conglomerating them").

As per claim 2, the rejection of claim 1 is incorporated and further, Bowler

discloses that **obtaining update content from one or more media remote**

from the destination machine via a network (p. 2 col. R:55-57 "including

intermediate computing systems or computer networks (e.g. the Internet or an

intranet, etc.) between the source computing system (i.e. remote media) and the

target computing system (i.e. destination machine)").

As per claim 3, the rejection of claim 2 is incorporated and further, Bowler

discloses that **the network is the Internet** (p. 2 col. R:55-57 "including

intermediate computing systems or computer networks (e.g. the Internet or an

intranet, etc.) between the source computing system (i.e. remote media) and the

target computing system (i.e. destination machine)").

As per claim 4, the rejection of claim 1 is incorporated and further, Bowler

discloses that **the update content includes at least one file** (p. 1 col. L:22-24

"a method and system for automatic transitioning of files among computer

systems").

As per claim 8, the rejection of claim 1 is incorporated and further, Bowler

discloses that obtaining update content comprises:

- analyzing hardware or software or both on the destination machine,

and obtaining, from the one or more update media remote from the

destination machine, update content specific to the analyzed hardware or

software or both on the destination machine (p. 5 col. R:51-54 "(The system

analyzes the hardware and/or software of the destination machine and) will not

install configuration settings (and software) for network applications that are not

available on the (destination machine)").

As per claim 9, the rejection of claim 8 is incorporated and further, Bowler

discloses one **or more computer readable media having computer-**

executable instructions for performing the method recited (p. 18 col. R:14-

15 "A computer readable medium having stored therein instructions for causing

a processor to execute the method (of the invention)").

As per claim 10, the rejection of claim 1 is incorporated and further,

Bowler discloses that **the software comprises operating system software or**

application program software or both (p. 1 col. L:35-37 "updated versions of

operating systems, new software applications and other improved features").

As per claim 12, the rejection of claim 1 is incorporated and further,

Bowler discloses **extracting at least one file from the update content** (p. 5 col.

R:57-59 "If the target computing system does not have TCP/IP installed, (then

the system extract that file from the update content)").

As per claim 13, the rejection of claim 1 is incorporated and further,

Bowler discloses that **pre-processing the update content in preparation for**

installation (p. 5 col. R:47-50 "The (update content is pre-processed based on)

... the operating system (and) services available on the target computing system,

(then applied to the target computing system)").

As per claim 14, the rejection of claim 1 is incorporated and further,

Bowler discloses that **the software comprises one or more files** (p. 1 col. L:22-

24 "a method and system for automatic transitioning of files among computer

systems"), **and further comprising searching the update content for each of**

the files, and searching the one or more installation media for each of the

files not found in the update content (p. 5 col. R:47-50 "The (update content

is located and) ... applied to the target computing system)").

As per claim 15, the rejection of claim 14 is incorporated and further,

Bowler discloses **specifying registry** (settings) **to automate installation of the**

updated software (p. 5 col. R:28-45 "Exemplary configuration settings included

in the (system, include) registry settings").

As per claim 16, the rejection of claim 14 is incorporated and further,

Bowler discloses **one or more computer readable media having computer-**

executable instructions for performing the method recited (p. 18 col. R:14-

15 "A computer readable medium having stored therein instructions for causing

a processor to execute the method (of the invention)").

As per claims 17-23, 25-28 and 30-35 , Bowler also discloses such

claimed limitations as addressed in claims 1-4, 8, 10 and 13 above.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to

be patented and the prior art are such that the subject matter as a whole would have been
obvious at the time the invention was made to a person having ordinary skill in the art to which
said subject matter pertains. Patentability shall not be negatived by the manner in which the
invention was made.

5.   Claims 5-7,11, 24 and 29 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Bowler, U.S. Patent Application No. 2002/0174329 in view of

Delo, U.S. Patent No. 6,237,144.

As per claim 5, the rejection of claim 1 is incorporated and further, Bowler

doesn't explicitly discloses that **the update content includes a patch**.

However, Delo, in an analogous environment, discloses that **the update**

content includes a patch (col. 9:43-45, "software developers are able to provide

enhancements, upgrades, patches, etc.").

Therefore, it would have been obvious to a person of ordinary skill in the

art, at the time the invention was made, to incorporate the teachings of Delo into

the system of Bowler to have the update content include a patch. The

modification would have been obvious because one of ordinary skill in the art

would have wanted the flexibility of making changes to existing software without

having to use the time and bandwidth required to replace the existing software.

As per claim 6, the rejection of claim 5 is incorporated and further, Bowler

discloses **modifying the software on the installation media prior to**

installation on the destination machine (p. 9 col. R:20-24, "(The) process may

also be used for extracting configuration settings (i.e. update content and

software) from multiple ... computing systems that are local or remote, and conglomerating them (i.e. modifying them)").

Bowler doesn't explicitly disclose that the **patch** modifies the software on the installation media prior to installation on the destination machine.

However, Delo, in an analogous environment, discloses the use of a **patch** (col. 9:43-45, "software developers are able to provide enhancements, upgrades, patches, etc.").

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Delo into the system of Bowler to have the patch modify the software on the installation media prior to installation on the destination machine. The modification would have been obvious because one of ordinary skill in the art would have wanted the flexibility of making changes to existing software, in any location, without having to use the time and bandwidth required to replace the existing software.

As per claim 7, the rejection of claim 1 is incorporated and further, Bowler doesn't explicitly disclose that the update content includes **a driver for controlling hardware on the destination machine** (col. 7:17-20 "associated device drivers provide the basic interface between the computer's hardware and software resources").

However, Delo, in an analogous environment, discloses that the update content includes **a driver for controlling hardware on the destination**

machine (col. 7:17-20 "associated device drivers provide the basic interface
between the computer's hardware and software resources").

Therefore, it would have been obvious to a person of ordinary skill in the
art, at the time the invention was made, to incorporate the teachings of Delo into
the system of Bowler to have the update content include a driver. The
modification would have been obvious because one of ordinary skill in the art
would have wanted to update the destination computer to allow it to control
additional hardware devices.

As per claim 11, the rejection of claim 1 is incorporated and further,
Bowler discloses that **merging the update content with the software
comprises one of the following: replacing, and adding to the software on
the one or more installation media** (p. 9 col. R:20-24, "(The) process may also
be used for extracting configuration settings (i.e. update content and software)
from multiple ... computing systems that are local or remote, and conglomerating
them", and p. 5 col. R:57-59 "If the target computing system does not have
TCP/IP installed, (then the system extracts that file from the update content)").

Bowler doesn't explicitly disclose **patching.** However, Delo, in an
analogous environment, discloses the use of **a patch** (col. 9:43-45, "software
developers are able to provide enhancements, upgrades, patches, etc.").

Therefore, it would have been obvious to a person of ordinary skill in the
art, at the time the invention was made, to incorporate the teachings of Delo into
the system of Bowler to have the update content include a patch. The

modification would have been obvious because one of ordinary skill in the art

would have wanted the flexibility of making changes to existing software without

having to use the time and bandwidth required to replace the existing software.

As per claims 24 and 29, the Bowler/Delo combination also discloses such

claimed limitations as addressed in claims 5 and 7 above.

Double Patenting

6.   A rejection based on double patenting of the "same invention" type finds
its support in the language of 35 U.S.C. 101 which states that "whoever invents
or discovers any new and useful process ... may obtain a patent therefor ..."
(Emphasis added). Thus, the term "same invention," in this context, means an
invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151
U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and
In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

7.   A statutory type (35 U.S.C. 101) double patenting rejection can be
overcome by canceling or amending the conflicting claims so they are no longer
coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a
double patenting rejection based upon 35 U.S.C. 101.

8.   Claims 1-35 are provisionally rejected under 35 U.S.C. 101 as claiming

the same invention as that of claims 1-19, 21-25, 27-32 and 35-39 of copending

Application No. 10044570. This is a <u>provisional</u> double patenting rejection since

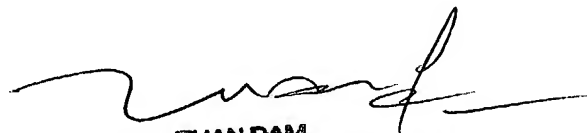the conflicting claims have not in fact been patented.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre R. Fowlkes whose telephone number is (703)305-8889. The examiner can normally be reached on Monday - Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703)305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ARF

TUAN DAM
SUPERVISORY PATENT EXAMINER